



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. 14

GRAY CARY WARE & FREIDENRICH LLP
153 TOWNSEND
SUITE 800
SAN FRANCISCO, CA 94107

COPY MAILED

MAY 13 2003

OFFICE OF PETITIONS

In re Application of :
Shi et al. :
Application No. 09/910,358 : DECISION DISMISSING PETITION
Filed: July 19, 2001 :
Attorney Docket No. 2101363-991200 :

This is a decision on the "Petition in Response to Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures," filed February 11, 2003. This petition is properly treated as a petition under 37 C.F.R. § 1.53(e)(2). Petitioners request correction of the record and inclusion of page 19 in the application at the time of the filing.

Application papers in the above-identified application were filed on July 19, 2001. However, on October 16, 2001, the Office of Initial Patent Examination (OIPE) mailed applicants a "Notice to File Corrected Application Papers." Applicants were thereby advised that the application had been accorded a filing date of July 19, 2001; however, the claim(s) commencing on a separate sheet (37 CFR 1.75(h)) and substitute computer readable form (CRF) of the sequence listing and statement under 1.821, as applicable, were required.

On January 28, 2002 (certificate of mailing December 10, 2001), applicants timely responded with *inter alia* a substitute specification (with the claims commencing on a separate sheet). However, on December 5, 2002, OIPE mailed applicants the Notice stating that page 19 of the specification appeared to have been omitted from the application. This Notice stated that a failure to timely file a petition would be treated as a constructive acceptance by the applicants of the application as deposited in the USPTO.

In response, applicants timely filed the instant petition (and petition fee). Applicants assert that page 19 of the application was included in the initial filing made on July 19, 2001 as indicated by the documents associated with the filing of the above-identified application. In support thereof, applicants pointed to indication on the Utility Patent Application Transmittal Letter and on the Fee Transmittal that page 19 of the specification was among the papers filed on July 19, 2001. In

addition, petitioner submitted a copy of their return postcard¹ from the USPTO.

A review of petitioner's evidence is not necessary to address whether page 19 of the specification was among the papers present in the application on filing. A review of the application file reveals that page 19 is present in the application and is considered (and always has been considered) a part of the original application disclosure. However, the Notice mailed December 5, 2002, was mailed in reference to the substitute specification filed January 28, 2002 (certificate of mailing December 10, 2001). A review of this paper as received in the Office reveals that page 19 appears to have been omitted.

Therefore, the Notice was properly mailed and will not be withdrawn.

In view thereof, the petition is **DISMISSED**.

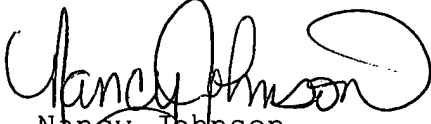
As petitioners have not shown that page 19 was among the papers filed on January 28, 2002, the Notice is considered correct and the petition fee is not subject to refund.

Petitioners are given **ONE (1) MONTH** from the mailing date of this decision to submit page 19 omitted from the substitute specification filed January 28, 2002. This period is not extendable under § 1.136(a).

The application, with a filing date of July 19, 2001, is being returned to the Office of Initial Patent Examination for completion of pre-examination processing, including awaiting receipt of page 19 of the substitute specification.

Telephone inquiries regarding this matter should be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.

Beverly Flanagan
Supervisory Petitions Attorney
Office of Petitions


Nancy Johnson
Petitions Attorney
Office of Petitions

¹ Petitioner is reminded that if the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO). See MPEP 503. Petitioner's postcard petition does not itemize the pages of specification or claims being submitted. Further, transmittal letters and fee transmittals do not generally serve as convincing evidence that any item listed thereon is present in the application.